

Remarks

This Amendment is in response to the Office Action dated **November 14, 2007**, wherein:

the Office alleged that the oath/declaration was defective; and
the Office rejected claims 23, 27 – 30, 32, 36 – 40, and 42 – 49, alleging the same to be unpatentable under 35 U.S.C. § 103.

Claims 23, 32, 42, and 46 have been amended.

The following comments are presented in the same order and with headings and paragraph numbers corresponding to those set forth in the Office Action.

Oath/Declaration

2. The Office rejected the declaration of the instant application. However, the MPEP states,

602.03 Defective Oath or Declaration
[R-5]

In the first Office action the examiner must point out every deficiency in a declaration or oath and require that the same be remedied.

(Emphasis added).

Applicant notes that the instant application was filed June 13, 2001. The first Office Action was mailed January 29, 2002; the Office never pointed out any deficiencies in the declaration by the inventor. Numerous Office Actions have been mailed between the first Office Action and the current Office Action, without reference to any deficiencies in the declaration. Based on the language of the MPEP requiring that the Office point out any deficiencies in the declaration in the first Office Action, the Office is estopped from now—nearly 6 years after the first Office Action—asserting that the declaration is defective. The MPEP requirement acknowledges the burdens and difficulties in producing a substitute declaration from an inventor after a lengthy period of prosecution.

Applicant traverses the rejection and respectfully requests its removal.

Claim Rejections – 35 U.S.C. § 103

4. The Office rejected claims 23, 27 – 30, 32, 36, 37, 39, 42, 44 – 46, and 49 under 35 U.S.C. § 103, alleging the same to be unpatentable over U.S. Patent No. 5,843,172 to Yan (hereafter “Yan”) in view of U.S. Patent No. 5,769,884 to Solovay (hereafter “Solovay”), and further in view of U.S. Patent No. 5,980,564 to Stinson (hereafter “Stinson”).

Claim 23 and Those Claims Dependent Therefrom

The purported combination of Yan, Solovay, and Stinson fails to teach or suggest all the limitations of amended claim 23. Amended claim 23 recites, “wherein the at least two regions have porosities of greater than about 50% to about 80% of the volume of the sintered metal.” (Emphasis added). Support for the amendment may be found at least on page 4, line 33 – page 5, line 1 of the original specification, which states “The sintered metal or polymer will exhibit a porosity ranging from less than 10 percent to about 80 percent of the total volume.”

The Office asserted that “Stinson discloses the porosity of a region of a stent being between 20% and 80% of the volume of the stent.” Applicant, however, has not found such a disclosure in Stinson. Rather, Stinson discloses that “[t]he pores when empty represent a volume percentage of from about 10% to about 50%.” (col. 7, lines 62 – 65).

Thus, claim 23, as amended, includes a range limitation wherein the lower limit of the range in claim 23 is greater than the upper limit of the range disclosed in Stinson. As such, Stinson fails to teach the range recited in claim 23.

One of ordinary skill in the art will recognize that there are significant non-obvious design challenges in creating a stent having a porosity “of greater than about 50% to about 80% of the volume of the sintered metal,” as recited in claim 23, that nevertheless maintains its structural integrity both during its delivery to a site within a body lumen as well as its expansion at that site.

Neither Yan nor Solovay teach or suggest the range of porosities recited in claim 23. Resultingly, because the combination of Yan, Solovay, and Stinson fails to teach or suggest all the elements of claim 23, claim 23 is non-obvious.

Claims 27 – 30, 42, 44, and 45 depend from independent claim 23. Because dependent claims are non-obvious if the claims from which they depend, claims 27 – 30, 42, 44,

and 45 are also non-obvious. Applicant requests that the rejection be withdrawn.

Claim 32 and Those Claims Dependent Therefrom

The purported combination of Yan, Solovay, and Stinson fails to teach or suggest all the limitations of amended claim 32. Amended claim 32 recites, “wherein the at least two regions have porosities of greater than about 50% to about 80% of the volume of the sintered metal.” (Emphasis added).

For at least the reasons presents above with regard to claim 23, claim 32 is also non-obvious.

Claims 46 and 49 depend from independent claim 32. Because dependent claims are non-obvious if the claims from which they depend, claims 46 and 49 are also non-obvious. Applicant requests that the rejections be withdrawn.

5. The Office rejected claims 38, 40, 43, 47, and 48 under 35 U.S.C. § 103, alleging the same to be unpatentable over Yan, Solovay, and Stinson as applied to claims 23, 32, and 47, and further in view of U.S. Patent No. 5,807,404 to Richter (hereafter “Richter”).

Claim 38

The purported combination of Yan, Solovay, Stinson, and Richter fails to teach or suggest all the elements of claim 38. Claim 38 depends from independent claim 32. Amended claim 32 recites, “wherein the at least two regions have porosities of greater than about 50% to about 80% of the volume of the sintered metal.” (Emphasis added). As argued above, Yan, Solovay, and Stinson fail to teach or suggest this limitation. The addition of any alleged teaching in Richter of “wherein the first and second side walls are non-parallel to the longitudinal axis of the stent,” as recited in claim 38, does nothing to address the failure of Yan, Solovay, and Stinson to teach the range of porosities recited in claim 32. As such, claim 38 is non-obvious. Applicant requests that the rejection be withdrawn.

Claim 40

The purported combination of Yan, Solovay, Stinson, and Richter fails to teach or suggest all the elements of claim 40. Claim 40 depends from independent claim 32. Amended claim 32 recites, “wherein the at least two regions have porosities of greater than about 50% to about 80% of the volume of the sintered metal.” (Emphasis added). As argued above, Yan, Solovay, and Stinson fail to teach or suggest this limitation. The addition of any alleged teaching in Richter of “at least some of the openings are bounded at a proximal end by a first serpentine segment made of a first metal and at a distal end by a second serpentine segment made of a second metal different from the first metal,” as recited in claim 40, does nothing to address the failure of Yan, Solovay, and Stinson to teach the range of porosities recited in claim 32. As such, claim 40 is non-obvious. Applicant requests that the rejection be withdrawn.

Claim 43

The purported combination of Yan, Solovay, Stinson, and Richter fails to teach or suggest all the elements of claim 43. Claim 43 depends from independent claim 23. Amended claim 23 recites, “wherein the at least two regions have porosities of greater than about 50% to about 80% of the volume of the sintered metal.” (Emphasis added). As argued above, Yan, Solovay, and Stinson fail to teach or suggest this limitation. The addition of any alleged teaching in Richter of “wherein a first portion of the tube is made from a first metal and a second portion of the tube, axially spaced from the first portion of the tube is made from a second metal different from the first metal,” as recited in claim 43, does nothing to address the failure of Yan, Solovay, and Stinson to teach the range of porosities recited in claim 23. As such, claim 43 is non-obvious. Applicant requests that the rejection be withdrawn.

Claim 47

The purported combination of Yan, Solovay, Stinson, and Richter fails to teach or suggest all the elements of claim 47. Claim 47 depends from independent claim 32. Amended claim 32 recites, “wherein the at least two regions have porosities of greater than about 50% to about 80% of the volume of the sintered metal.” (Emphasis added). As argued above, Yan, Solovay, and Stinson fail to teach or suggest this limitation. The addition of any alleged teaching in Richter of “wherein a first portion of the tube is made from a first metal and a second

portion of the tube, axially spaced from the first portion of the tube is made from a second metal different from the first metal,” as recited in claim 47, does nothing to address the failure of Yan, Solovay, and Stinson to teach the range of porosities recited in claim 32. As such, claim 47 is non-obvious. Applicant requests that the rejection be withdrawn.

Claim 48

The purported combination of Yan, Solovay, Stinson, and Richter fails to teach or suggest all the elements of claim 48. Claim 48 depends from independent claim 32. Amended claim 32 recites, “wherein the at least two regions have porosities of greater than about 50% to about 80% of the volume of the sintered metal.” (Emphasis added). As argued above, Yan, Solovay, and Stinson fail to teach or suggest this limitation. The addition of any alleged teaching in Richter of “disposing a first treatment agent into the pores of the first portion of the tube and disposing a second treatment agent into the pores of the second portion of the tube,” as recited in claim 48, does nothing to address the failure of Yan, Solovay, and Stinson to teach the range of porosities recited in claim 32. As such, claim 48 is non-obvious. Applicant requests that the rejection be withdrawn.

Conclusion

For at least the reasons presented above, Applicants believe that the application is in condition for allowance. Favorable consideration and prompt action to that effect are respectfully solicited.

Should the Examiner have any questions regarding the response, the Examiner is invited to contact the Applicants' undersigned representative at the number listed below.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

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